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In re Application of:
David G. McCarthy
Application No.: 08/951,276
Filed: October 16, 1997
For: RETRACTABLE RECEPTACLE FOR FURNITURE

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a)(3) filed on December 11, 2003, invoking the supervisory authority of the Director to review the decision of the Group Director of Technology Center 2800 (Group Director), which decision refused to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences.

The petition under 37 CFR 1.181(a)(3) to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences is **DENIED**.

BACKGROUND

The final rejection of August 31, 1999, included: (1) a rejection of claims 1 through 20 under 35 U.S.C. § 112, first paragraph as containing subject matter not described in the specification; (2) a rejection of claims 1, 2 , 6, and 16, as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 4,747,788; (3) a rejection of claims 19 and 20 as anticipated by U.S. Patent No. 4,511,198; and (4) a rejection of claims 3 through 5, 7 through 16, and 17, 18 under 35 U.S.C. § 103(a) over U.S. 4,747,788.

On December 2, 1999, applicant filed a notice of appeal, followed on January 19, 2000 by applicant's brief on appeal. On April 11, 2000, the examiner's answer was mailed. The examiner's answer expressly withdrew the grounds of rejection under 35 U.S.C. §§ 102, 103, but maintained the rejection under 35 U.S.C. § 112, first paragraph.

On October 31, 2002, the Board of Patent Appeals and Interferences issued a decision that noted (at 2) that the rejections under 35 U.S.C. §§ 102, 103 had been withdrawn by the examiner, and reversed the rejection of claims 1 through 20 under 35 U.S.C. § 112 first paragraph.

On March 7, 2003, an Office action was mailed which reopened prosecution by re-applying the prior art references that had been previously employed in the final rejection and then withdrawn in the examiner's answer. The Office action (at 7) was signed, *inter alia*, by the Group Director.

On April 15, 2003 applicant filed a petition seeking that the reopening of prosecution by the Office action of March 7, 2003, be vacated on the grounds that such lacked compliance with 37 CFR 1.198. On December 11,2003, the Group Director denied the petition on the grounds that the contested reopening was authorized under the terms of 37 CFR 1.198.

The instant petition was filed December 11, 2003.

REGULATION AND EXAMINING PROCEDURE[1]

37 CFR 1.198 provides that:

> Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.04 states in pertinent part:

> If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

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[1] Manual of Patent Examining Procedure ("MPEP") (8th ed 2001) (Rev. 2, May 2004)

DECISION

Petitioner contends that as the examiner had withdrawn all rejections of the claims over the same prior art references, coupled with the fact that the examiner permitted the appeal to be decided only on the formal grounds *i.e.*, the rejection based on 35 U.S.C. § 112, first paragraph, "is at the least, an implicit admission" by the examiner that the claims are considered allowable over that prior art. Petitioner further complains that the decision fails to provide any explanation why the current grounds of rejection were not made by the examiner prior to the decision by the Board of Patent Appeals and Interferences (BPAI). Petitioner further contends that the re-application of the previously applied, and withdrawn, references, "violates 37 CFR 1.198."

While it is unfortunate that the examiner did not present the current rejections over the same prior art references, such that the BPAI could have all issues before it when the decision of October 31, 2002 was rendered, the reopening of prosecution herein is neither improper under nor inconsistent with 37 CFR 1.198.

The record shows that the prior art-based rejections in the final Office action of August 31, 1999 were not carried forward into the examiner's answer of April 11, 2000. Therefore, the BPAI treated the prior art-based rejections as withdrawn and not before the BPAI for review. See Ex parte Emm, 118 USPQ 180, 181 (Bd. Pat. App. 1957).[2] The instant situation is akin to the situation in In re Freeman, 166 F.2d 178, 76 USPQ 585 (CCPA 1948), in which: (1) the examiner rejected claims in the application on the basis of (*inter alia*) double patenting; (2) the double patenting rejection was withdrawn by the examiner before the application was forward to the Board of Appeals for a decision on the remaining rejections; (3) the Board of Appeals sustained the rejection of some claims but reversed the rejection of other claims; and (4) the examiner obtained approval to reopen prosecution for the purpose of rejecting claims in the application on the basis of (*inter alia*) double patenting. In response to arguments similar to those being made by petitioner, the CCPA indicated that the fact that the examiner withdrew the double patenting rejection prior to the initial appeal does not preclude the examiner from reopening prosecution (upon obtaining the appropriate approval) and rejecting the claims on the basis of double patenting. See Freeman, 166 F.2d at 179-80, 76 USPQ at 586. Therefore, that the examiner withdrew the prior art-based rejections in the final Office action of August 31, 1999 does not preclude the examiner from obtaining approval to reopen prosecution under 37 CFR 1.198 for the purpose of entering the previously withdrawn prior art based rejections of the claims.

The authority to permit the reopening of prosecution subsequent to a decision by the BPAI under 37 CFR 1.198 has been delegated to the Group Director. See MPEP 1002.02(c), ¶ 1. The Office action that reopened prosecution was signed by the Group Director, thus indicating that the

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[2] Inasmuch as the prior art-based rejections were not before the BPAI for review , these rejections have not already been adjudicated by the BPAI, by "default" or otherwise.

Group Director approved the examiner's request to reopen prosecution in the above-identified application. It is well established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director why the application should not issue, the Director has the duty, much less the authority, to refuse to issue the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896). The questions of patentability set forth in the Office action of March 7, 2003 are "sufficient cause" for reopening prosecution in the above-identified application under 37 CFR 1.198.

CONCLUSION

The instant petition is granted to the extent that the decision of the Group Director has been reviewed, but is **denied** as to making any change therein. As the reopening of prosecution in the above-identified application was consistent with 37 CFR 1.198, the Group Director's refusal to vacate the reopening of prosecution subsequent to the decision of the Board of Patent Appeals and Interferences will **not** be disturbed.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Brian Hearn at (571) 272-3217.

Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy